

Remarks

I. Status of Claims

Claims 1-24, 58-60 and 62 are pending in the present application and have been examined.

Claims 1-15, 17-19, 21-23, and 58-60 stand rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1-15, 17-19, 21-23, and 58-60 stand rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skill in the art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claims 1-15, 17-19, 21-23, and 58-60 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 16, 20, 24 and 62 are allowed.

II. Response to the Rejection of 1-15, 17-19, 21-23 and 58-60

Under 35 U.S.C. §112, First Paragraph

The Patent Office rejected claims 1-15, 17-19, 21-23 and 58-60 under 35 U.S.C. §112, first paragraph, because the specification, while being enabling for a nucleic acid of SEQ ID NO:1, encoding SEQ ID NO:2, does not reasonably provide enablement for a polynucleotide which is an allelic variant, or a splice variant of the polynucleotide encoding the protein encoded by SEQ ID NO:1. After careful consideration of the rejection, applicants submit the following comments.

Applicants remain of the opinion that those of ordinary skill in the art would readily be able to prepare KCNQ5 variants that would reflect the activities and/or features characteristic of KCNQ5, particularly those having the biological activity described in the specification. Nonetheless, solely in order to advance prosecution, applicants have cancelled claims 1-15, 17-19, 21-23 and 58-60.

III. Response to the Rejection of Claims 1-15, 17-19, 21-23 and 58-60

Under 35 U.S.C. §112, First Paragraph

The Patent Office rejected claims 1-15, 17-19, 21-23 and 58-60 under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicants remain of the position that one of ordinary skill in the art would understand the inventions had possession of the claimed invention. However, as noted herein above, applicants have canceled claims 1-15, 17-19, 21-23 and 58-60, rendering the instant rejection of these claims moot.

IV. Response to the Rejection of Claims 1-15, 17-19, 21-23 and 58-60

Under 35 U.S.C. §112, First Paragraph

The Patent Office rejected claims 1-15, 17-19, 21-23 and 58-60 under 35 U.S.C. §112, second paragraph as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants are of the position that the element "biologically active" is clearly defined in the specification and that, consequently, the rejected claims are not indefinite. Nevertheless, applicants have canceled claims 1-15, 17-19, 21-23 and 58-60, rendering this rejection moot.

V. Conclusions

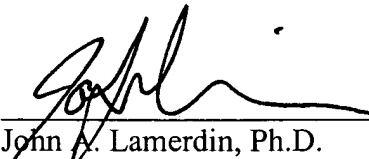
In light of the above amendments and remarks, applicants respectfully submit that the subject patent application is now in condition for allowance and courteously solicit a Notice of Allowance.

If any small matter should remain outstanding after the Patent Examiner has had an opportunity to review the above Amendments and Remarks, the Patent Examiner is respectfully requested to telephone the undersigned patent attorney in order to resolve these matters and avoid the issuance of another Official Action.

Although it is believed no fee is due, the Commissioner is hereby authorized to charge any deficiency or credit any overpayment associated with the filing of this correspondence to Deposit Account Number 19-3880 in the name of Bristol-Myers Squibb Company.

Respectfully submitted,

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Date: January 14, 2004